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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,215	01/29/2004	Vito Tortelli	108910-00119	3929

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EXAMINER

KEYS, ROSALYND ANN

ART UNIT PAPER NUMBER

1621

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,215

Applicant(s)

TORTELLI ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/24/04.
- 4) ☒ Interview Summary (PTO-413B)
Paper No(s)/Mail Date: 20050513
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Status of Claims

1. Claims 1-11 are pending.
Claims 1-11 are rejected.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on June 24, 2004 has been considered by the examiner.

Specification

4. The disclosure is objected to because of the following informalities: on page 2, line 15 the word ---group--- is misspelled; on page 2, line 16 the phrase "since they allow to" is not grammatically correct. Perhaps the phrase should say "since they allow one to"

Appropriate correction is required.

Claim Objections

5. Claim 7 is objected to because of the following informalities: in line 9 the word ---and--- before the word --such-- should be deleted; in line 10 the word --be-- should be changed to --is--; in line 15 the word --and-- should be inserted between --n-- and --m--, also the word --and-- before the word --such-- should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, ***claim 1*** recites the broad recitation RO-, wherein R is a (per)fluorinated substituent, and the claim also recites preferably perfluorinated which is the narrower statement of the range/limitation; In the present instance, ***claim 1*** recites the broad recitation selected from the following groups: linear or branched C₁-C₂₀ alkyl, and the claim also recites preferably C₁-C₁₀, which is the narrower statement of the range/limitation; In the present instance, ***claim 1*** recites the broad recitation at temperatures from 120°C to -20°C, and the claim also recites preferably from -100°C to -40°C, which is the

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narrower statement of the range/limitation; and In the present instance, **claim 6** recites the broad recitation wherein the number average molecular weight of R_f in formula (II) and (III) ranges from 66 to 12,000, and the claim also recites preferably from 66 to 1,000, more preferably from 300 to 800 which are the narrower statements of the range/limitation;

9. Claim 9 recites the limitation $B-(CF_2CF_2O)_t(CF_2O)_p$ in line 2. There is insufficient antecedent basis for this limitation in the claim. Structure B is not disclosed in claim 1, it is however disclosed in claims 7 and 8.

10. Claims 2-5, 7, 8, 10 and 11 are indefinite because they depend from an indefinite claim. Ex parte Cordova, 10 U.S.P.Q.2d 1949, 1952 (P.T.O. Bd. App. 1989).

Allowable Subject Matter

11. Claims 1-11 are allowable over the prior art of record.

12. The following is a statement of reasons for the indication of allowable subject matter: Guglielmo et al. (US 4,900,872) and Tortelli et al. (US 6,853,856 B2) each teach methods for preparing (per)fluorohalogenethers having the claimed formula (II) using a compound having the claimed formula (IV) as a starting material. However, neither of the references teach or fairly suggest reacting the compound having the claimed formula (IV) with a compound having the claimed formula (III) $R''COF$. In the claimed formula (III) oxygen is always attached to COF. Guglielmo et al. teach using a fluoroxy compound having the general formula $(R)_nC(F)_m-OF$ and Tortelli et al. teach using a carbonyl compound having the formula (II) $(R)_pC(F)_q(O)$. In Tortelli et al. none of the expressly disclosed compounds having the formula (II) have oxygen attached directly to COF (see column 2, lines 63-68).

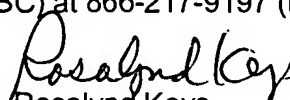
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sianesi et al. (US 3,721,696) teach preparation of compounds having the claimed formula (III).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-TR 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalynd Keys
Primary Examiner
Art Unit 1621

May 13, 2005